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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,836	08/31/2001	Royce D. Jordan JR.	010558	2808
26285	7590	10/22/2004	EXAMINER	
KIRKPATRICK & LOCKHART LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222			EDELMAN, BRADLEY E	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/943,836

Applicant(s)

JORDAN, ROYCE D.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/5/02, 9/19/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is a first office action on this application. Claims 1-37 are presented for examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Notably, the “gateway identifying information” claimed is not disclosed in the specification. Claim 12 requires that the identifying indicia of claim 1 is “gateway identifying information.” However, the specification does not describe what sort of “information” this includes. The specification merely reiterates the claim language – i.e. “unique indicia tag [is] derived from... identifying information for the gateway 14” (p. 6, last sentence), and “gateway data,” (p. 12, last sentence). The specification does not describe what type of gateway information is used to indicate forwarding of attachments, and does not describe how such information would be used. Thus, the claim language of claim 12 is not enabled by the specification.

2. Claim 12 is further rejected under 35 U.S.C. 112, second paragraph, because the “identifying information” described in the claim is vague and unclear. Neither the specification nor the claim clarifies what is meant by the term “identifying information.” A gateway can have millions of pieces of identifying information associated with it, but the specification fails to disclose even one specific type of information that would clarify the claim language.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-10, 12-30, and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Mousseau et al. (U.S. Patent No. 6,438,585, hereinafter “Mousseau”).

In considering claim 1, Mousseau discloses a method for processing data in a wireless communication network (Fig. 1), comprising:

receiving at least one electronic message having at least one attachment associated therewith (Fig. 7, step 220; col. 16, lines 43-47);

associating identifying indicia with said message in accordance with at least one characteristic of said message (col. 8, lines 19-23, “type of attachment”); and

determining whether to transmit said attachment to a recipient of said message based on said identifying indicia (col. 8, lines 19-27).

In considering claim 2, Mousseau further discloses transmitting at least a portion of said message to a wireless application of said recipient in accordance with said determining step (col. 8, lines 19-27, wherein the message is sent either with or without the attachment).

In considering claim 3 Mousseau further discloses that the transmitted portion includes an indicia tag having at least a portion of said identifying indicia located therein (col. 16, lines 47-52, “sends the datagram to the mobile with information about the attachment”; col. 17, lines 20-22, wherein the “type of attachment” information is supplied to the recipient).

In considering claim 4, Mousseau further discloses that the indicia tag includes a unique identifier associated with said message (col. 8, lines 35-40, wherein the determination is made based on a unique sender address indicia identified with the message).

In considering claim 5, Mousseau further discloses that the transmitted portion includes clear text (i.e. e-mail text).

In considering claim 6, Mousseau further discloses stripping at least a portion of said message in accordance with said determining step (i.e. the attachment may be stripped).

In considering claim 7, Mousseau further discloses stripping said attachment from said message (col. 16, lines 50-52).

In considering claim 8, Mousseau further discloses storing said attachment after stripping said attachment (col. 6, lines 45-52, the attachment may be sent to a “store”).

In considering claim 9, Mousseau further discloses receiving said message through a connection to the Internet (col. 7, line 63).

In considering claim 10, Mousseau further discloses receiving said message from a wireless data network (the system allows two-way e-mail messaging from wired or wireless devices).

In considering claim 12, Mousseau further discloses that identifying indicia includes gateway identifying information (i.e. information related to the host system that associates the user’s wireless device with the user’s e-mail address; see col. 8, lines 8-28).

In considering claim 13, Mousseau further discloses transmitting said portion of said message through a wireless data network (the e-mail is sent to a wireless device; col. 6, lines 56-60).

In considering claim 14, Mousseau further discloses transmitting said portion of said message through a wireless data network to a wireless application (i.e. it is sent to a user’s PDA or pager; col. 6, lines 56-60).

In considering claim 15, Mousseau further discloses that said wireless application is selected from the group consisting of a pager, a personal digital assistant, a wireless telephone, a wireless computer, a digital camera, and a digital camera including a self-contained web-cam (col. 6, lines 56-60).

In considering claim 16, Mousseau further discloses transmitting said portion of said message to said recipient and incorporating in said message portion an indication of one or more attachments stripped from said message (col. 16, lines 47-52; col. 17, lines 20-26).

In considering claims 17-19, Mousseau further discloses determining further processing of at least one of said stripped attachments, wherein said further processing includes processing at least one of said stripped attachments in a subsystem, wherein said subsystem includes an apparatus selected from the group consisting of a computer, a fax machine, a database, a telephone, and a printer (col. 16, lines 47-52; col. 17, lines 20-26; col. 8, lines 23-27).

Claims 20 and 23 describe a system and computer program product for performing the same steps as claim 1, and are thus rejected for the same reasons.

Claims 21 and 24 describe a system and computer program product for performing the same steps as claim 2, and are thus rejected for the same reasons.

Claims 22 and 25 describe a system and computer program product for performing the same steps as claim 5, and are thus rejected for the same reasons.

In considering claim 26, Mousseau discloses a system for processing an electronic message having at least one attachment associated therewith in a wireless communication network, said system comprising:

a gateway structured with an internal network to receive electronic messages from at least one source ("host system 10," col. 8, lines 12-14);

said gateway structured to identify each said electronic message with an indicia tag representative of at least one characteristic of said electronic message (col. 8, lines 19-27, wherein the host system detects attachment types of the messages); and

said gateway structured to transmit at least a portion of each of said electronic messages to a recipient of said message in accordance with said indicia tag, wherein said transmitted portion includes at least clear text (col. 15, lines 46-57, wherein the e-mail datagrams are sent as text).

In considering claim 27, Mousseau further discloses at least one mail router for receiving said electronic messages from the Internet (i.e. the mail server).

In considering claim 28, Mousseau further discloses that at least one of said mail routers is structured to handle traffic selected from the group consisting of inbound Internet traffic, outbound Internet traffic, and X-sockets traffic (col. 7, line 63).



In considering claim 29, Mousseau further discloses at least one message store for storing said electronic messages (col. 7, lines 65-66).

In considering claim 30, Mousseau further discloses at least one user database containing information for at least one user of said gateway (col. 16, lines 30-35).

In considering claim 33 Mousseau further discloses that at least one of said user databases is structured to receive instructions for filtering said electronic messages (col. 16, lines 30-40; col. 8, lines 35-40).

In considering claim 34 Mousseau further discloses at least one protocol handler for processing said electronic messages (col. 11, lines 19-20).

In considering claim 35 Mousseau further discloses at least one N Router machine for receiving said electronic messages in said gateway when said source is a wireless data network and transmitting said electronic messages to a recipient when said source is the Internet (col. 6, lines 56-67, wherein the system is a 2-way wireless paging system for e-mail, thus allowing the user gateway device to both send and receive messages to and from either the Internet or a wireless medium).

In considering claim 36, Mousseau further discloses at least one subsystem structured to process said messages in response to an instruction of said recipient (col. 17, lines 17-25).

In considering claim 37, Mousseau further discloses that the subsystem is selected from the group consisting of a computer subsystem, a fax machine subsystem, a database subsystem, a telephone subsystem, and a printer subsystem (col. 6, lines 45-50).

2. Claims 1-3, 5-10, 13-15, 20-31, and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Foladare et al. (U.S. Patent No. 6,311,210, hereinafter "Foladare").

In considering claim 1, Foladare discloses a method for processing data in a wireless communication network, comprising:

receiving at least one electronic message having at least one attachment associated therewith (col. 5, lines 44-51; col. 6, lines 20-23);

associating identifying indicia with said message in accordance with at least one characteristic of said message (col. 6, lines 33-40, wherein the central electronic mail device determines which attachments to forward based on attachment file type); and

determining whether to transmit said attachment to a recipient of said message based on said identifying indicia (col. 6, lines 33-40).

In considering claim 2, Foladare further discloses transmitting at least a portion of said message to a wireless application of said recipient in accordance with said determining step (col. 5, lines 55-57; col. 6, lines 33-40).

In considering claim 3 Foladare further discloses that the transmitted portion includes an indicia tag having at least a portion of said identifying indicia located therein (col. 5, lines 34-40, wherein if the attachment is forwarded, the indication of file type will be forwarded as well).

In considering claim 5, Foladare further discloses that the transmitted portion includes clear text (i.e. e-mail text).

In considering claim 6, Foladare further discloses stripping at least a portion of said message in accordance with said determining step (i.e. the attachment may be stripped).

In considering claim 7, Foladare further discloses stripping said attachment from said message.

In considering claim 8, Foladare further discloses storing said attachment after stripping said attachment (i.e. it is stored at the centralized electronic mail device).

In considering claim 9, Foladare further discloses receiving said message through a connection to the Internet (col. 2, lines 64-65, "ISP").

In considering claim 10, Foladare further discloses receiving said message from a wireless data network (the system allows two-way e-mail messaging from wired or wireless devices; col. 3, lines 2-4).

In considering claim 13, Foladare further discloses transmitting said portion of said message through a wireless data network (the e-mail is sent to a wireless pager, etc.).

In considering claim 14, Foladare further discloses transmitting said portion of said message through a wireless data network to a wireless application (i.e. it is sent to a user's PDA or pager).

In considering claim 15, Foladare further discloses that said wireless application is selected from the group consisting of a pager, a personal digital assistant, a wireless telephone, a wireless computer, a digital camera, and a digital camera including a self-contained web-cam (col. 3, lines 2-4).

Claims 20 and 23 describe a system and computer program product for performing the same steps as claim 1, and are thus rejected for the same reasons.

Claims 21 and 24 describe a system and computer program product for performing the same steps as claim 2, and are thus rejected for the same reasons.

Claims 22 and 25 describe a system and computer program product for performing the same steps as claim 5, and are thus rejected for the same reasons.

In considering claim 26, Foladare discloses a system for processing an electronic message having at least one attachment associated therewith in a wireless communication network, said system comprising:

a gateway structured with an internal network to receive electronic messages from at least one source (“centralized electronic mail device 160,” col. 5, lines 44-45);

said gateway structured to identify each said electronic message with an indicia tag representative of at least one characteristic of said electronic message (col. 6, lines 34-40); and

said gateway structured to transmit at least a portion of each of said electronic messages to a recipient of said message in accordance with said indicia tag, wherein said transmitted portion includes at least clear text (col. 6, lines 34-40, wherein the e-mail is sent as text).

In considering claim 27, Foladare further discloses at least one mail router for receiving said electronic messages from the Internet (i.e. the mail server).

In considering claim 28, Foladare further discloses that at least one of said mail routers is structured to handle traffic selected from the group consisting of inbound Internet traffic, outbound Internet traffic, and X-sockets traffic (col. 2, lines 64-65).

In considering claim 29, Foladare further discloses at least one message store for storing said electronic messages (inherent at the mail server).

In considering claim 30, Foladare further discloses at least one user database containing information for at least one user of said gateway (Fig. 3; col. 5, lines 10-25).

In considering claim 31, Foladare further discloses that at least one of said user databases is structured to verify user access to said gateway (Fig. 3, "access address" and "receiving party id").

In considering claim 33 Foladare further discloses that at least one of said user databases is structured to receive instructions for filtering said electronic messages (Fig. 3; col. 5, lines 10-25).

In considering claim 34 Foladare further discloses at least one protocol handler for processing said electronic messages (inherent in receiving electronic mail messages).

In considering claim 35 Foladare further discloses at least one N Router machine for receiving said electronic messages in said gateway when said source is a wireless data network and transmitting said electronic messages to a recipient when said source is the Internet (col. 3, lines 1-4, wherein the system is a 2-way wireless paging system for e-mail, thus allowing the user gateway device to both send and receive messages to and from either the Internet or a wireless medium).

In considering claim 36, Foladare further discloses at least one subsystem structured to process said messages in response to an instruction of said recipient (col. 7, lines 8-10, wherein messages can be retrieved by the recipient on demand).

In considering claim 37, Foladare further discloses that the subsystem is selected from the group consisting of a computer subsystem, a fax machine subsystem, a database subsystem, a telephone subsystem, and a printer subsystem (col. 7, lines 8-14).

3. Claims 1-11, 13-15, 20-34, 36, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda et al. (U.S. Patent No. 6,275,850, hereinafter "Beyda").

Beyda discloses a similar wireless-based message attachment processing system as both Mousseau and Foladare, and is thus rejected for similar reasons. Claims 1-11, 13-15, 20-34, 36, and 37 are disclosed in col. 3, line 53 – col. 4, line 61, and col. 7, lines 1-60 of Beyda.

Particularly regarding claim 11, Beyda discloses that the message characteristic used as identifying criteria is a file size of the attachment (col. 7, lines 8-12).

Particularly regarding claim 31, Beyda discloses that the user database verifies user access to the messaging gateway (col. 3, lines 63-67).

Particularly regarding claim 32, Beyda discloses that the user database is structured to permit signatures to be associated with said messages (i.e. user ID and password are used to receive the messages).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mousseau.

In considering claim 31, although Mousseau does not explicitly disclose that at least one of said user databases is structured to verify user access to said gateway, Mousseau does disclose including both encryption and other security measures in the wireless attachment-processing system (col. 16, lines 30-31; col. 9, lines 49-62). Given this teaching, it would have been obvious to a person having ordinary skill in the art to include additional security features, such as verifying user access to the user's gateway device, in order to make the system even more secure.

In considering claim 32, along the same lines as claim 31, given the teachings of Mousseau regarding security and encryption, it would have been obvious to further include digital signatures or other authentication signatures to be associated with the sent messages, in order to increase security of the system.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mousseau, in view of Beyda.

In considering claim 11, as discussed above, Mousseau discloses filtering attachments based on file type, and Beyda discloses filtering attachments based on format or file size. Thus, it would have been obvious to add the feature of filtering attachments based on file size to the attachment processing system of Mousseau, because PDAs and pagers cannot easily process extremely large files.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Bradley Edelman*

BE  
October 15, 2004